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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,996	05/03/2001	Thomas Heidemann	49521	7150
26474	7590	11/05/2003		
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 11/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/830,996

Applicant(s)

HEIDEMANN ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/7/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) ~~1-8~~<sup>1-3, 6</sup> is/are pending in the application.
- 4a) Of the above claim(s) 9-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Final Rejection***

#### **The Status of Claims**

Claims 1-8 are pending.

Claims 1-8 have been rejected.

*Claims 9-26 have been withdrawn.*

#### **Claim Objections**

The objection of Claims 7 and 8 has been withdrawn due to modification made in the amendment.

#### **Claim Rejections-35 USC 102**

1. Applicants' argument filed 8/7/2003 have been fully considered but they are not persuasive.

*Rejection of Claims 1-8 under 35 U.S.C. 102(b) as being anticipated clearly by Takada et al (U.S. 4,965,151) has been changed to rejection of claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over Takada et al (U.S. 4,965,151).*

The rejection of Claims 1-8 under 35 U.S.C. 102(b) as being anticipated clearly by Takada et al (U.S. 4,965,151) has been changed to the rejection of Claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over Takada et al (U.S. 4,965,151).

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1625

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al (U.S. 4,965,151).

Takada et al discloses a multimetal oxide  $\text{Ag}_x\text{V}_2\text{O}_{5-y}$ , where  $x$  is between 0.6 and 0.8 and  $y$  is 0 and 5. (see col. 3, lines 10-11).

However, the instant invention differs from the prior art reference in that the claimed compound has specified the values of X-ray diffraction pattern and specific surface area, and a mean ratio of fiber diameter to fiber length.

With respect to the physical properties based on the crystal morphology, the reference is silent. However, these are not related to the novelty of the instant invention, but rather are naturally obtained as the unique physical properties, such as X-ray diffraction pattern in the process of evaluating the crystal structure. Furthermore, the selection of specific surface area, and the mean ratio of fiber diameter to fiber length are not a patentable modification in the absence of unexpected results. Therefore, it would have been obvious to the skillful artisan in the art to have motivated to obtain the claimed specific surface area and the mean ratio of fiber diameter to fiber length of the compound as part of routinely evaluating physical characteristics for the known compound in the process of the storage.

### ***Response to Argument***

2. The applicants argue the following issue:

1. Takada et al has not provided an extrinsic evidence with respect to the claimed crystal metal oxide morphology.

The applicants' argument have been noted, but these arguments are not persuasive.

First, with regard to the first argument, the Examiner has noted applicants' argument. However, these are not related to the novelty of the instant invention, but rather are naturally obtained as the unique physical properties, such as X-ray diffraction pattern in the process of evaluating the crystal structure. Furthermore, the selection of specific surface area, and the mean ratio of fiber diameter to fiber length are not a patentable modification in the absence of unexpected results. Therefore, it would have been obvious to the skillful artisan in the art to have motivated to obtain the claimed specific surface area and the mean ratio of fiber diameter to fiber length of the compound as part of routinely evaluating physical characteristics for the known compound in the process of the storage.

Therefore, the reference is relevant to the claimed invention.

### ***Conclusion***

Art Unit: 1625

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*Taylor Victor Oh*  
11/2/09

*Margaret Seaman*  
D. MARGARET SEAMAN  
PRIMARY EXAMINER